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Customer Number 27045

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has amended claim 1 and claims 3-6, 10, 13-36 were previously canceled. Accordingly, claims 1-2, 7-9, 11-12, and 37-50 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks. Claim 1 was amended in order to more fully define the scope of the present invention. Support for the amendment may be found throughout the specification, including page 2, lines 23 and 29.

2.) Claim Rejections – 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 2, 7, 11, 12, 37-42 and 44-49 under 35 U.S.C. § 102(b) as being anticipated by Haynes, et al. (GB 2,322,521). The Applicant respectfully traverses this rejection.

Haynes relates to a telecommunications system comprising a GSM cellular telephone network of which some of the subscribers can also make and receive calls via satellite (when they are out of range of the GSM network) (Haynes, page 1, first paragraph). The system also comprises a main storage means for storing details of the subscribers to that network and a local storage means responsive to a registration request from a mobile telecommunications unit of a subscriber for obtaining that subscriber's details from the main storage unit and temporarily storing them to enable calls to be routed to and from that mobile telecommunications unit (Haynes, page 3, first paragraph).

In contrast, claim 37 (an exemplary claim) is reproduced below:

37. A method for communicating device operating capabilities between a first mobile station and a second mobile station, wherein the first mobile station is served by a first switch node, wherein the first switch node is associated with a storage means, the method comprising:

receiving data indicating the device operating capabilities associated with the first mobile station, wherein the data is communicated

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without establishing a call connection between the first mobile station and the first switch node;

storing the communicated data within the storage means;

receiving a call setup message from the first mobile station to establish an outgoing call connection towards the second mobile station;

retrieving the stored data within the storage means; and

including the retrieved data within the outgoing call setup message to allow the data to be reviewed by a second switch node serving the second mobile station for device compatibility so that negotiation of operating capabilities take place between the first switch node and the second switch node.

Similarly, claim 1 states:

1. A method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising:

receiving a first list of operating capabilities of a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station,

storing the operating capabilities of the first mobile station at the first node,

receiving a second list of operating capabilities of a second mobile station at a second node upstream of and associated with the second mobile station wherein the list is received prior to setting up the call with the second mobile station,

storing the operating capabilities of the second mobile station at the second node,

comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node.

The Office Action claims that the element of "receiving a first list of operating capabilities of a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station" is taught by Haynes. The Applicant respectfully disagrees. The passage cited by the Office Action is reproduced below:

When the dual-mode MTU 17d is powered up (and activated by a particular subscriber's SIM), its registration request, including its IMSI, is passed by VLR 12 to the access node 40. The access node is arranged to carry out a check on the IMSI to establish whether or not the particular

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MTU 17d is being used by a subscriber having a current subscription permitting access by satellite. For this purpose, the access node 40 is provided by the satellite network operator with all necessary up to date information to enable the access node 40 to carry out the verification process.

The Applicant fails to understand how this cited passage of Haynes reads on the claim limitation of "receiving a first list of operating capabilities of a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station." The operating capabilities of a first mobile station of claim 1 (or the device operating capabilities of claim 37) is not the subscriber information of Haynes. In Haynes, the IMSI is passed to for the verification process. In Haynes, the verification process is based on the subscriber data – not on the operating capabilities of the mobile units.

If the examiner is implying that the "subscriber data" of Haynes reads on the "operating capabilities" of the present application, then the Applicant respectfully traverses this interpretation.

For instance, on page 1, lines 19-27, of the Present Specification, the Application states:

In general, when a subscriber having a mobile station (MS) or terminal located within a first PLMN wishes to contact another subscriber having a mobile station or terminal located in a different PLMN, the first mentioned subscriber's MS must transmit to its serving mobile switching centre (MSC) operating capabilities, such as, a codec or a list of codecs on which it can transmit information or messages. Negotiation must then be initiated, typically over a fixed switched network, such as PSTN, or ISDN, IP or ATM with the other mobile station or terminal. Once the operating capabilities are negotiated between the two mobile stations then the call may proceed using those capabilities.

Thus, it is clear that the operating capabilities of a first mobile station refers to the operating capabilities of the device (which is explicitly stated in claim 37). In contrast, the subscriber data of Haynes is device independent and refers to verification data for the subscriber. For instance, the subscriber's details "include the subscriber's IMSI (International Mobile Identification Number), his public telephone number, information for use for authentication purposes, billing information, and information identifying the

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extent of the subscriber's subscription – in particular, whether the subscriber is permitted to roam (that is, make or receive calls via networks outside the subscriber's home country) or whether the subscriber may only use his MTU in his home country." (Haynes, page 13, lines 1-7).

It is also clear that Haynes teaches a system independent of the mobile phone. Refer to the following passage from Haynes:

The subscriber uses the SIM to activate an MTU 17 then becomes identified by the SIM as being used by that particular subscriber. In principle, of course, the subscriber can activate any suitable MTU 17 by means of the SIM card. Therefore, references in this specification to a particular subscriber's MTU are references to any MTU when activated by that subscriber's SIM.

Thus, it is clear that Haynes does not even contemplate "receiving a first list of operating capabilities of a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station." All that is contemplated by Haynes is subscriber information for verification purposes.

Similarly, Haynes does not disclose or imply "storing the operating capabilities of the first mobile station at the first node" because Haynes does not contemplate using the operating capabilities of the first mobile station.

The Applicant also disagrees with the Examiner's assertion that Haynes on page 26, teaches "a comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node." There is simply no mention of a first list of operating capabilities of a first mobile phone, nor a second list of operating capabilities of a second mobile phone. There is also nothing that implies a comparing of the two lists "such that the negotiation of agreed upon operating capabilities take place between the first node and the second node."

As the PTO provides in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim...." Therefore, Haynes must disclose all of the

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elements of the claims to sustain the rejections. Clearly, Haynes does not even teach one of the claim elements.

MPEP § 2131 requires that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Claim 1 recites comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node. In contrast, nowhere does Haynes teach or suggest a comparison of operating capabilities which leads to a negotiation. Accordingly, Haynes fails to disclose or suggest all the claimed elements or the manner in which they interconnect as required by MPEP § 2131.

Independent claims 37 and 44 contain similar elements which are also not found in Haynes. In fact, claims 37 and 44 use the term "device operating capabilities." Thus, claims 37 and 44 are allowable for similar reasons. The dependent claims depend from the independent claims and recite further limitations in combination with the novel elements of the independent claims. Therefore, the allowance of the dependent claims is also respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 8, 9, 43 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Haynes or possibly Welling. The Applicant respectfully traverses this rejection.

It is not clear whether the Examiner is basing his rejection from Haynes or Welling. It appears that the Examiner has simply repeated a previous rejection without even bothering to replace the term "Welling" by the term "Haynes." In any event, the Applicant respectfully requests clarification on which reference the Examiner is basing his rejection. If the Examiner is basing his rejection on Welling, then the Applicant incorporates the Applicant's remarks submitted on August 4, 2004.

As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not

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produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office Action does not factually support a prima facie case of obviousness for claims 8, 9, 43 and 5 based on Haynes. The Applicant incorporates here the arguments made above in that Haynes does not teach the elements of independent claims. Therefore, Haynes does not teach all of the elements of claims 8, 9, 43, and 5.

The Examiner admits that the additional elements of claims 8, 9, 43 and 50 are not taught by Haynes and has used "official notice" to justify this rejection. As the Examiner is aware, in order preserve the Applicant's right to traverse this assertion in later actions, the Applicant must traverse this assertion in this Office Action. Therefore, the Applicant respectfully objects to the Examiner's use of official notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the Applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2).

Pursuant to 37 CFR 1.104(d)(2), the Applicant again respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may have a chance to explain the reference in later actions. As opposed to the last Office Action, the Applicant respectfully requests that the Examiner respond to the challenge of Official Notice.

In any event, as explained above with respect to the 102 rejection, Haynes does not teach all of the elements of the independent claims. Similarly, Haynes does not teach all of the elements of the dependent claims. So, according to the MPEP 2143, an obvious rejection is not proper and should be withdrawn.

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CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



Date: May 15, 2005

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